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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,695	09/24/2001	Rikuro Obara	861975/32	1907

7590 06/12/2003  
Schulte Roth & Zabel LLP  
919 Third Avenue  
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EXAMINER

ANDREWS, MELVYN J

ART UNIT PAPER NUMBER

1742

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/887,695

Applicant(s)

OBARA ET AL.

Examiner

Melvyn J. Andrews

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 to 9 and 12 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al (US patent No.5,030,017) alone or in view of EPO 592 195. Murakami et al discloses a rolling bearing comprising an alloy steel consisting essentially of carbon, chromium, silicon, manganese, oxygen, titanium and balance iron in ranges which overlap the claimed ranges of these elements as well as fine carbide with particle size of 0.5-1.0  $\mu\text{m}$  and a surface hardness  $H_{RC}$  of 65-70 (col.12, lines 15 to 37 which also overlap the claimed ranges; but the Murakami et al range of 10-25% of retained austenite", does not overlap the claimed range of "having more than 0% and less than 10 % by volume of retained austenite", nevertheless, even though the ranges of "retained austenite" do not overlap, the prior art range and the claimed range are close enough so that one of ordinary skill in the art at the time the invention was made would have expected these steels to have the same properties so that the claimed bearing is obvious in view of Murakami et al. Titanium Metals Corp. of Am. Vs. Banner, 227 USPQ 773

With respect to the bearing structure the patent to Murakami et al does not explicitly disclose a bearing comprising an inner ring and an outer ring or a shaft with an outer ring but EPO'195 discloses such structures (see Fig.1 and page 2, lines 30 to 41

as well as Fig.2 page 3, lines 21 to 37) which bearings would have been obvious to form the Murakami et al alloy steel since bearings are being made in both cases.

### ***Response to Arguments***

Applicants arguments filed April 7, 2003 are not persuasive.

With respect to the "low-end" of the range "having more than 0% ... by volume of retained austenite" the Murakami et al a bearing being subject to a working induced transformation of retained austenite which is converted to martensite i.e. hardened (col.5, lines 49 to 63) so that it is obvious that any "retained austenite" even an impurity reads on the range "having more than 0%...by volume of retained austenite". Titanium Metals Corp. of Am. Vs. Banner, 227 USPQ 773

With respect to the "high end" of the range Murakami et al discloses that "the content of the retained austenite in the surface layer was 10-25 %" (col.6, lines 28 to 32) which abuts the claimed "less than 10 % by volume retained austenite" but this is close enough such that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of Am. Vs. Banner, 227 USPQ 773

The data submitted to overcome Murakami et al is not persuasive because it is unclear. Tables I, II and III do not identify the source of the bearings identified by "PART NUMBERS" and it is unclear why no anti-friction bearings as claimed by applicants have been tested by Laboratory Testing Inc. With respect to Table IV the source of this data is not clearly set forth; the reference to Table 4 on page 10 of the "Response" is indefinite. In any case no comparative data has been provided by the Laboratory Testing Inc which clearly compared the claimed bearing with any prior art

bearing and did not shown a patentable difference between the claimed steel bearing and the Murakami et al steel bearing . .

It is noted that the evidence has not been presented by way of an oath or declaration. MPEP 716.

In response to applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Anderon data) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 1 to 9 and 12 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obara et al (US 5,843,369) in view of Murakami et al (.US 5,030,017). Obara et al discloses martensitic stainless steel used for an antifriction bearing (col.1, lines12 to 15) but does not disclose a stainless steel with "retained austenite" in a range which overlaps the claimed range of "having more than 0% and less than 10 % by volume of retained austenite", nevertheless, Murakami et al discloses that a bearing is subject to a working induced transformation of retained austenite which is converted to martensite i.e. hardened (col.5, lines 49 to 63) but any "retained austenite" even an impurity reads on the range "having more than 0%... by volume of retained austenite" so that even though the ranges of "retained austenite" do not overlap, the prior art range and the claimed range are close enough so that one of ordinary skill in the art at the time the invention was made would have expected these

steels to have the same properties so that the claimed bearing is obvious in view of  
Murakami et al. Titanium Metals Corp. of Am. Vs. Banner, 227 USPQ 773

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 9 and 12 to 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 10 of U.S. Patent No. 5,843,369 in view of Murakami et al. (US 5,030,01). Although the conflicting claims are not identical, they are not patentably distinct from each other because Obara et al. claims a stainless steel used for an antifriction bearing defined in the specification as martensitic stainless steel (col.1, lines 12 to 15) but does not claim a stainless steel with "retained austenite" in a range which overlaps the claimed range of "having more than 0% and less than 10 % by volume of retained austenite", nevertheless, Murakami et al. discloses that a bearing is subject to a working induced transformation of retained austenite which is converted to martensite i.e. hardened (col.5, lines 49 to 63) but any

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"retained austenite" even an impurity reads on the range "having more than 0%...by volume of retained austenite" so that even though the ranges of "retained austenite" do not overlap, the prior art range and the claimed range are close enough so that one of ordinary skill in the art at the time the invention was made would have expected these steels to have the same properties so that the claimed bearing is obvious in view of Murakami et al. Titanium Metals Corp. of Am. Vs. Banner, 227 USPQ 773

### ***Conclusion***


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvyn J. Andrews whose telephone number is 703-308-3739. The examiner can normally be reached on 8:00A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

  
**MELVYN ANDREWS**  
**PRIMARY EXAMINER**

mja  
June 11, 2003